

Appl. No.: 10/800,448
Art Unit: 3711 Docket No.: B04-10
Reply to Office Action of February 28, 2005

REMARKS

Claims 1-4 and 6-12 appear in this application for the Examiner's review and consideration. Claim 1 has been amended to include the recitations of canceled claim 5. Claim 5 has been cancelled without prejudice to Applicant's right to file one or more continuing applications directed to any subject matter not presently claimed. No new matter has been added by these amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 11 was rejected under 35 U.S.C. § 112, second paragraph. The Examiner stated that it is unclear whether the one multi-lobed dimple is surrounded by the six lobed dimples or if the one multi-lobed dimples is surrounded by six additional multi-lobed dimples. Applicant submits that it is clear that the hexagonal array includes one multi-lobed dimple surrounded by six dimples that are also multi-lobed. Thus, the six additional multi-lobed dimples do not necessarily have six lobes each.

The rejection under 35 U.S.C. § 112, second paragraph, is therefore believed to have been overcome. Applicant respectfully requests reconsideration and withdrawal thereof.

Rejections Over U.S. Patent No. 6,547,678

Claims 1 and 6-9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,547,678 to Barfield *et al.* ("Barfield"). Barfield is generally directed to a golf ball with dimple structures having vortex generators.

For claims to be rejected under 35 U.S.C. § 102(e), each and every element as set forth in the claims of the present invention must be found, either expressly or inherently, in a single prior art reference. Applicant respectfully submits that Barfield does not disclose all the elements of the claimed invention.

Amended independent claim 1 is directed to a golf ball comprised of dimples having a plurality of lobes where curved profiles of the lobes abut each other in an uninterrupted manner. More particularly, the curved profiles of the lobes continuously and smoothly extend into each other. The Examiner alleges that FIGS. 7-9 of Barfield show curved profiles of the lobes abutting each other in an uninterrupted manner such that the curved profile of one lobe

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continuously and smoothly extends to and abuts with the curved profile of an opposite or near opposite lobe. Applicants disagree.

The Barfield reference teaches that a golf ball can have lobed dimples, but teaches that the profile of the dimple has first and second edge projections or "vortex generators" 44a, 44b. (See col. 5, lines 6-48). Similarly, in the dimples shown in FIGS. 11-13 the vortex generators are any adjacent linear segments: (56a-56b, 56b-56c, 56c-56a) for FIG. 11; (56d-56e, 56f-56g) for FIG. 12; and (56h-56i, 56h-56k, 56j-56l) for FIG. 13. (See col. 6, lines 12-24, 38-42 and 54-59). Thus, the Barfield reference does not teach smooth curved profiles like the present invention. FIGS. 6-9 show the vortex generators, which are specifically interruptions to the curved profile of the dimples. Thus, the Barfield patent teaches the exact opposite of curve profiles that extend continuously and smoothly from one lobe to an abutting lobe.

Accordingly, independent claim 1 is believed to be in condition for allowance for at least the reasons set forth above. Moreover, the remaining claims 6-9 depend from independent claim 1 discussed above and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claim. As such, Applicant respectfully requests that the rejection under 35 U.S.C. § 102(e) be reconsidered and withdrawn.

In the Office Action, Claims 2-4 and 10-12 were rejected under 35 U.S.C. § 103(a) as being obvious over Barfield.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, not in Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Barfield fails to teach or suggest all the recitations of independent claim 12. Barfield fails to disclose that the number of lobes for each multi-lobed dimple is the same as the number of dimples surrounding the multi-lobed dimple, as recited in independent claim 12 of the present invention. Specifically, as illustrated in FIG. 14, Barfield discloses dimples with three lobes 40b surrounded by six dimples and dimples having five lobes 40d surrounded by six dimples. Thus, Barfield does not teach or suggest that the number of lobes for each multi-lobed dimple be the

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same as the number of dimples surrounding the multi-lobed dimple. Thus, claim 12 is believed patentable over the cited reference.

Dependent claims 2-4 and 10-11 depend from independent claim 1 and add additional features. These claims are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claim. Thus, claims 2-4 and 10-11 are patentable for at least the same reasons set forth above.

The rejections under 35 U.S.C. § 103(a) are believed to have been overcome for at least the above reasons. Applicant respectfully requests reconsideration and withdrawal thereof.

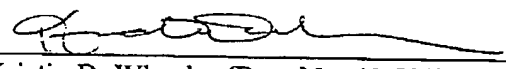
Conclusion

Based on the remarks set forth above, Applicant believes that all of the rejections have been overcome and the claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicant's attorney would further the prosecution of this application, the Examiner is encouraged to call the attorney at the number below.

No fee is believed to be due for this submission. However, should any required fees be due, please charge them to Acushnet Company Deposit Account No. 502309.

Respectfully submitted,

20 May 05
Date


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